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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/994,059

11/27/2001

Jacques Quellais

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1287

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08/21/2006

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ALEXANDRIA, VA 22314

EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/994,059

Applicant(s)

QUELLAIS ET AL.

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16, 20, 21, 23, 25-27 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-39 is/are allowed.
- 6) ☒ Claim(s) 1, 5-7, 9, 11-13, 20, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 2-4, 8, 10, 14-16, 21, 23, and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5-7, 9, 11-13, 20, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salzman (4186500) in view of Marxer (4723364).

Salzman shows a shoe comprising a ground contacting layer (11) which is molded and forms arc shaped stops at the toe and heel portions in "recesses" of an intermediate layer (30) which covers "the entire" ground contacting surface, and a comfort layer (50) substantially as claimed except for the exact materials for the comfort layer. Marxer states that the use of synthetic foam for a lining/comfort layer is well known and conventional (see column 3 lines 23-26). It would have been obvious to make the comfort/lining layer from sythetic foam, i.e. a material having elastic shock absorption properties, as is conventional and stated by Marxer in the shoe of Salzman to make the shoe comfortable.

In reference to claims 5-7 and 9, Salzman as modified above discloses the claimed invention except for the exact materials. It would have been obvious to one having ordinary skill int he art at the time the invention was made to use the materials claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In reference to claims 11-13, the specific method of attaching the layers appears to have no importance as Salzman states "the liner is secured in any conventional manner" (column 3 lines 58-59) or is silent as to how the layers are connected. It would have been obvious to use any known method of attachment including adhesive bonding, duplicate molding, and ultrasound. The presence of claims 11-13 is evidence that the invention is indifferent, i.e. there is no criticality, to the specific one of the conventional methods.

***Allowable Subject Matter***

3. Claims 2-4, 8, 10, 14-16, 21, 23, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claims 33-39 are allowed.

***Response to Arguments***

5. Applicant's arguments filed 7/21/06 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards Salzman, the sole is made up of layers 50, 30, and 11, i.e. the portion of the shoe which lies under the sole of the foot and the upper (formed by element 21 is surmounted, i.e. it stand and lies at the top of the sole (see attached marked up drawing). The fact that element 50 has both a sole portion and an upper portion does not negate the fact that there is a sole portion of 50 which forms part of the sole of the shoe. In reference to the upper portion of 50, the upper 21 is clearly shown as mounted above and lies on top of the entire portion 50 and

therefore the layers of the sole are external to the portion of 50 which forms the upper inasmuch as applicant has defined such in the claims.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (572)272-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson  
Primary Examiner  
Art Unit 3728